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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.            | CONFIRMATION NO.       |
|---|-------------|----------------------|--------------------------------|------------------------|
| 10/620,711  | 07/16/2003  | Weiling Peng         | 129843.001071                  | 9592                   |
| 60148 7590 08/24/2007<br>GARDERE / JAMES HARDIE<br>GARDERE WYNNE SEWELL, LLP<br>1601 ELM STREET<br>SUITE 3000<br>DALLAS, TX 75201 |             |                      | EXAMINER<br>GILBERT, WILLIAM V |                        |
|   |             |                      | ART UNIT<br>3635               | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>08/24/2007        | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/620,711

Applicant(s)

PENG, WEILING

Examiner

William V. Gilbert

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-71 is/are pending in the application.
- 4a) Of the above claim(s) 2,9-14 and 23-70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,15-22 and 71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 05 July 2007, 08 June 2007.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

This is a Final Office Action. Claim 2 has been cancelled.

Claims 1, 3-8, 15-22 and 71 are pending.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 3-8, 15-18, 22 and 71 are rejected under 35 U.S.C. 102(e) as being anticipated by Weiss (U.S. Patent No. 6,949,160).**

Claim 1: Weiss discloses a protected pre-finished fiber cement product (Fig 1; Column 4, lines 60-65), with a finish layer (16) applied to the product, a protective layer (22) adhered to the finished layer with an adhesive (the fact that the film is adhered to the finished layer means adhesive properties are involved), the protective layer protects the

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finish layer, the protective layer leaves no residue when removed (see where the surface of the panel is tack-free, Col. 4, lines 32-40; Col. 10, lines 8-19), and the layer resists tearing on removal (Col. 13, lines 40-50; the fact that the layer can be removed means the film resists tearing).

Claims 3 and 4: the adhesive is ethylene/acrylic (which has acidic properties; Col. 14, lines 55-67.)

Claim 5: it is inherent that the adhesive would be between the finish layer of the panel and the protective layer in order for the protective coating to adhere to the panel.

Claims 6-8: the protective layer is a polymer (Column 14, lines 25, 26, per Claim 6), and is polyethylene (Claims 7 and 8).

Claims 15-17: the protective layer meets the thickness limitations as claimed (Col. 5, lines 1-6).

Claim 18: Weiss discloses a plurality of pre-finished fiber cement products (Column 3, lines 39-42) arranged in a stack (Abstract: lines 3-7), a finish layer (Fig. 1: 16) applied to the product, and a protective layer (22) applied to the finish layer with an adhesive (the fact that the film is adhered to the finished layer means adhesive properties are involved), where the protective layer protects the finish layer from damage in storage, removing the layer leaves no residue on the finish

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layer (Col. 10, lines 8-15), and the layer resists tearing on removal (it is inherent that the coating resists tearing on removal; Col. 13, lines 40-50.)

Claim 22: the products are banded together (Column 3, lines 42-44).

Claim 71: Weiss discloses a fiber-cement product (Col. 3, lines 39-42) that has a finish layer (Fig. 1: 16) applied to a product, a multilayer film (a portion that is the adhesive portion that adheres to the panel, and the second portion, or layer, has no adhesive characteristics in that it prevents stacked panels from adhering to each other; Col. 3, lines 40-45), the film is removable (Col. 13, lines 40-50), and the film does not leave a residue (Col. 10, lines 8-15).

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 19-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss.

Claim 19: Weiss discloses the claimed invention including the products are stacked (Column 3, line 40), but not on a pallet. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to stack the products on a pallet because it is well known in the art to stack such products on pallets to ease in transportation and storage.

Claims 20 and 21: Weiss discloses the claimed invention except for the orientation of the stacked products. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to stack the materials in the manner in the claims because since a protective coating is on

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the material, the aesthetic surface will not suffer damage from placing a product on top of it.

***Response to Arguments***

3. The following addressed Applicant's Arguments dated 08 June 2007.

Applicant's amendment to the Claims overcome the 35 U.S.C. §112 rejection and the rejection is withdrawn.

Applicant's arguments filed 08 June 1007 have been fully considered but they are not persuasive.

In reference to Applicant's arguments (page 12 of Remarks) that the prior art of record (Weiss, U.S. Patent No. 6,949,160) does not disclose the protective layer is adhered to the finish layer with an adhesive, Weiss does disclose that the layer is adhered to the finish layer (see rejection above). As a result of this adhesion, it is inherent that adhesive properties are present in the layer, which the Examiner concludes that the '160 reference does have a film adhered to a finish layer with an adhesive.

Regarding Applicant's arguments to Claims 19-21, the Examiner still contends that the use of a pallet is well known

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in the art (see, e.g. Morrison, U.S. Patent No. 4,404,057: Col. 5, lines 50-55) for the use and transport of panels and stock goods. Further, with respect to Claims 20 and 21, the orientation of the faces of the panels is not relevant in the stacking process because the '160 reference notes that the purpose of the film is to protect the finish layer and not adhere to a panel that is stacked on top of it (Col. 3, lines 40-45).

Applicant's arguments with respect to claims 3-5, 15-17 and have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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20 Aug 07  
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